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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,847	09/27/2000	Yoichi Okano	FQ5-488	6526
21254	7590	03/02/2004	EXAMINER	
MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			JAMAL, ALEXANDER	
		ART UNIT		PAPER NUMBER
		2643		13
DATE MAILED: 03/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/669,847	OKANO, YOICHI	
	Examiner	Art Unit	
	Alexander Jamal	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05 January 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.
 4a) Of the above claim(s) 2 and 12 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,3-11,13-27 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10.12</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Withdrawal of Objections

1. Based upon the submitted amendments, examiner withdraws objections from the prior office action (July 8th, 2003) to the Title of Invention.

Withdrawal of Claims

2. Examiner acknowledges the withdrawal of **Claims 2 and 12**. They have been removed from consideration.

Response to Arguments

3. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
2. **Claims 1-20,26** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described

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in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1,8,11,18-20,26 all refer to obtaining time information as to the last time that “talk” with another person was established, for use in applicant’s invention (this is further specified in applicant’s arguments page 12 section I. Paragraph 1). The specification refers to a “last communication time of day” between the user and intended recipient that is updated by a “last access time of day”. The specification page 17 describes that the “last access time of day” is updated whenever a user obtains a connection with a recipient’s phone number, then terminates the call (Specification page 17 line 1 to Page 18 line10). Applicant’s specification provides no means to determine if actual “talk” has occurred between the two parties. For example, if one of the two parties immediately hangs up the phone without talking, or if the called party has an answering machine that ‘picks up’ the phone line and records a message, the applicant’s invention (as per the specification) will still record the termination of the phone call as the “last access” or “last communication” time of day. There is no way to differentiate whether actual talk with a person was established. As such, Claims 1-20,26 are rejected.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 21,22,25** rejected under 35 U.S.C. 102(e) as being anticipated by Shaffer et al. (6477374).

a. **Claim 21:** Shaffer discloses a communication system with a special ‘enhanced call back’ feature that comprises an alert function (method) comprising:

i. The name and other comments may be entered into a phonebook database via the window 1250a of Figure 13D. In addition, Shaffer’s method includes producing the alert ‘a predetermined amount of time after the caller hung up initially’ (Col 16 lines 15 to 38). This method inherently implies that the last communication time (the time the call to the person was **terminated**) is stored in the phonebook database for the purpose of being able to provide the correct callback alerts with the correct entries stored in the database.

ii. Since the method comprises alerting a user “a predetermined time after the caller hung up” (Col 16 lines 30-65), it must use the previously stored time data to make the determination as to when the call-back alert should be made.

iii. When the predetermined time interval has elapsed without communication, the user is alerted (Col 16 lines 25-38).

b. **Claim 22:** In Shaffer’s system, the last communication time could be the same as the initial communication time (the time at which the reminder is initially set). The call-back feature sends an alert to the user a predetermined time after the initial call has ended

(Col 16 lines 27-38). In the case where the predetermined time is 0 seconds or some other short amount of time (less than the amount of time it takes to complete and terminate an additional phone connection between the two parties), then the last communication time will be the initial communication time. This is a viable alternative for Shaffer's system in the case where a busy user may need to contact multiple people as soon as possible but is not able to get in contact with one particular person the first time they are called. In the case where the predetermined time is zero a reminder window will immediately pop-up so that the busy user is instantly reminded to try and contact the person again. In this manner, contact with the particular person is not forgotten amid contacting the remaining people that must be contacted asap.

c. **Claim 25:** Shaffer discloses a telecommunication system (which inherently comprises a telephone apparatus for the purpose of communicating with the network) with a special 'enhanced call back' feature that comprises:

i. The name and other comments may be entered into a phonebook database via the window 1250a of Figure 13D. In addition, Shaffer's method includes producing the alert 'a predetermined amount of time after the caller hung up initially' (Col 16 lines 15 to 38). This method inherently implies that the last communication time (the time the call to the person was **terminated**) is stored in the phonebook database for the purpose of being able to provide the correct callback alerts with the correct entries stored in the database.

- ii. Since the apparatus comprises alerting a user “a predetermined time after the caller hung up” (Col 16 lines 30-65), it must use the previously stored time data to make the determination as to when the call-back alert should be made.
- iii. When the predetermined time interval has elapsed without communication, the user is alerted (Col 16 lines 25-38).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 23,24** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al (6477374) and further in view of Groff (4405839).

a. **Claim 23:** Shaffer discloses a communication system with a special ‘enhanced call back’ feature that comprises an alert function comprising:

- i. The name and other comments may be entered into a phonebook database via the window 1250a of Figure 13D. In addition, Shaffer’s method includes producing the alert ‘a predetermined amount of time after the caller hung up initially’ (Col 16 lines 15 to 38). This method inherently implies that the last communication time (the time the call to the person was **terminated**) is stored in the phonebook database for the purpose of being able to provide the correct callback alerts with the correct entries stored in the database.

- ii. Since the method comprises alerting a user "a predetermined time after the caller hung up" (Col 16 lines 30-65), it must use the previously stored time data to make the determination as to when the call-back alert should be made.
- iii. When the predetermined time interval has elapsed without communication, the user is alerted (Col 16 lines 25-38).

However, Shaffer fails to teach an alert inhibition controller that:

- iv. Stores an alert-inhibition time period in which alert is inhibited (Col 2, lines 21-30).
- v. After the time interval has elapsed, the system alerts the caller (or user) if the time of day falls out of the alert-inhibition time period, and the caller (or user) may try another phone call
- vi. Inhibits an alert if it falls into the alert-inhibition period (Col 1 lines 50-55).

Groff teaches that a telephone subscriber desires to selectively silence the ringer of his telephone (communications device) when he doesn't want to be disturbed. Based on this information, it would have been obvious to one of ordinary skill in the art at the time of this application to implement an alert inhibition controller (that stores an inhibition time and implements the inhibition time) within shaffer's communication system so that the user could silence or inhibit the alerting feature without having to

disable the entire communications device (and risk forgetting to re-enable the communications device) (Col 1, lines 11-43).

b. **Claim 24:** In Shaffer's system, the last communication time could be the same as the initial communication time (the time at which the reminder is initially set). The call-back feature sends an alert to the user a predetermined time after the initial call has ended (Col 16 lines 27-38). In the case where the predetermined time is 0 seconds or some other short amount of time (less than the amount of time it takes to complete and terminate an additional phone connection between the two parties), then the last communication time will be the initial communication time. This is a viable alternative for Shaffer's system in the case where a busy user may need to contact multiple people as soon as possible but is not able to get in contact with one particular person the first time they are called. In the case where the predetermined time is zero a reminder window will immediately pop-up so that the busy user is instantly reminded to try and contact the person again. In this manner, contact with the particular person is not forgotten amid contacting the remaining people that must be contacted asap.

3. **Claims 27** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al (6477374) and further in view of Groff (4405839).

a. **Claim 27:** Shaffer discloses a telecommunication system (which inherently comprises a telephone apparatus for the purpose of communicating with the network) with a special 'enhanced call back' feature that comprises:

- i. The name and other comments may be entered into a phonebook database via the window 1250a of Figure 13D. In addition, Shaffer's method includes producing the alert 'a predetermined amount of time after the caller hung up initially' (Col 16 lines 15 to 38). This method inherently implies that the last communication time (the time the call to the person was **terminated**) is stored in the phonebook database for the purpose of being able to provide the correct callback alerts with the correct entries stored in the database.
- ii. Since the apparatus comprises alerting a user "a predetermined time after the caller hung up" (Col 16 lines 30-65), a controller must use the previously stored time data to make the determination as to when the call-back alert should be made.
- iii. When the predetermined time interval has elapsed without communication, the user is alerted (Col 16 lines 25-38).

However, Shaffer fails to teach an alert inhibition function comprising:

- iv. An alert-inhibition timetable in which alert is inhibited.
- v. After the time interval has elapsed, the system alerts the caller (or user) if the time of day falls out of the alert-inhibition time period, and the caller (or user) may try another phone call
- vi. The controller inhibits an alert if it falls into the alert-inhibition period (Col 1 lines 50-55).

Groff teaches that a telephone subscriber desires to selectively silence the ringer of his telephone (communications device) when he doesn't want to be disturbed. Based on this information, it would have been obvious to one of ordinary skill in the art at the time of this application to implement an alert inhibition controller (that stores an inhibition time and implements the inhibition time) within Shaffer's communication system so that the user could silence or inhibit the alerting feature without having to disable the entire communications device (and risk forgetting to re-enable the communications device) (Col 1, lines 11-43).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 703-305-3433. The examiner can normally be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 703-305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9315 for After Final communications.

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AJ

February 25, 2004

[Signature]

DUC NGUYEN
PRIMARY EXAMINER